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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,834	12/02/2004	Radi Al-Rashed	50216	7329

22929 7590 11/01/2007  
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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,834	<b>Applicant(s)</b> AL-RASHED, RADI	
	<b>Examiner</b> Paul Marcantoni	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 20, 21, and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The applicants' 9/20/07 election of Group I, claims 1-11, 20,21, and 23-25 is acknowledged. It is also noted that the non-elected cannot and will not be rejoined unless the claims that are determined allowable are also amended to be of the same exact scope as the potentially allowable subject matter.

35 USC 112 Second Paragraph:

Claims 1-11, 20,21, and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The applicants independent claims 1, 10, 23, and any other is indefinite because applicants do not provide the "total parts by weight" of their claimed mixture or composition. Notice how Patel does teach in the original disclosure and claims a total parts by weight of 100 parts by weight. Applicants do not particularly point out and distinctly claim their specific total parts by weight and thus their mixture claims are indefinite.

The terms "water associated problems" is vague and indefinite in claim 10 and any other claims it is used. What exactly do applicants mean by this term and what are the specific water associated problems to which they refer? Clarification is respectfully requested or deletion of these terms to resolve this issue.

The applicants should delete usage of parentheses in their claims as well as this is improper and indefinite. Simply writing out the terms without the parentheses would resolve this issue wherever parentheses are used (and of course deleting all parentheses in pending claims).

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New Matter:

Claims 1-11, 20,21, and 23-25 are rejected under 35 U.S.C. 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed:

The terms "wherein the mixture includes between 3.000% and 10.000% parts by weight alkali metal silicate solids" is new matter. There is no literal support for this limitation in the original disclosure.

35 USC 102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 20,21, and 23-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Patel '716.

Patel teaches the same composition or mixture for concrete application in the same amounts thus anticipating applicants' claims. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

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Response:

The applicants argue that they do not agree Patel teach an emulsifier. The examiner disagrees. Applicants are referred to column 3, line 29 which indicates that the polymers can be in the form of an emulsion and thus the presence of an emulsifying agent would have been apparent to one of ordinary skill in the art.

The applicants also argue the range of 3 to 10 parts by weight alkali metal silicate solids yet this has no support from the original disclosure and is new matter. The applicants also argue that the amount of alkali silicate differs from their instantly claimed invention. Again, applicants' new limitation of amount of alkali metal silicate is new matter. Second, applicants do not provide total parts by weight of their mixture. Patel at least is clear that the total parts by weight of his mixture is 100 parts. (The examiner notes that this Patel patent was issued yet the examiner should not have left parentheses in the claims and should have removed). There is no way to compare the amounts of applicants' claimed mixture and the prior art for the reasons provided above. Nevertheless, all of applicants' remarks or arguments have been addressed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1793